

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on April 11, 2006. A petition for a three month extension of time and an RCE (request for continued examination) is attached.

In this Amendment, claims 1-14 and 26 are canceled, claims 15, 27-35 are amended, and claims 36-47 are added so that claims 15 and 27-47 are pending and subject to examination.

I. Rejections based on Bagnulo (U.S. Patent No. 3,686,747)

Claims 1-2, 5, 8, 10-11, 13-15, and 26 are rejected as being anticipated by Bagnulo (US Patent No. 3,686,747). Claim 4 is rejected over Bagnulo and Shea et al. (US Patent No. 5,505,497). Claim 6 is rejected over Bagnulo and Nishio (U.S. Patent No. 6,045,164). Claims 31-32 are rejected as obvious over Bagnulo. Claims 3, 7, 12, and 33-35 are rejected over Bagnulo and Shea (U.S. Patent No. 5,383,994). Claims 9, 27, and 29 are rejected as being obvious over Bagnulo and Williams et al. (U.S. Patent No. 5,951,154). Claims 28 and 30 are rejected over Bagnulo, Williams et al. (U.S. Patent No. 5,951,154) and Shea (U.S. Patent No. 5,383,994). Each of these rejections is traversed.

Independent claim 15 is directed to a "duct assembly" with a first "constant diameter" duct and a second "constant diameter" duct. Independent claim 36 recites a similar limitation. FIGS. 1 and 7 in the present application show examples of constant diameter ducts.

Bagnulo fails to anticipate the claims. In Bagnulo, the alleged "ducts" are presumably metallic tubular members 1 and 2. However, the tubular members 1 and 2 are "conically flared" (c. 1, l. 52-53), and therefore do not have a "constant diameter." Accordingly, Bagnulo does not anticipate the claims.

Bagnulo also fails to render the claims obvious, because modifying Bagnulo's tubular members 1 and 2 with a "constant diameter" would render Bagnulo's pipe union inoperative. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.01. If a proposed

modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01. Here, it is an "object" of Bagnulo's pipe union invention to have tubular members that are "conically flared" (c. 1, l. 52). According to Bagnulo, the ends of the tubular members are conically flared so that they can be pressed against inner flanges 10, 10a to form a positive sealing assembly (c. 3, l. 15-20). Thus, if one were to modify the tubular members 1 and 2 in Bagnulo with a "constant diameter", a positive sealing assembly would not be formed, and the "object" of Bagnulo's invention would not be achieved. Thus, there is no motivation to modify Bagnulo to arrive at the inventions of independent claims 15 and 36, with or without the various secondary references cited in the various obviousness rejections.

II. Rejections based on Williams et al. (U.S. Patent No. 5,961,154)

At page 14 of the Office Action, claims 1-3, 5, 7-15, and 26-35 are rejected as obvious over Williams et al. (U.S. Patent No. 5,961,154) and Shea (U.S. Patent No. 5,383,994). Claim 4 is rejected over Williams, Shea (U.S. Patent No. 5,383,994), and Shea et al. (U.S. Patent No. 5,505,497). Claim 6 is rejected as being obvious over Williams et al., Shea, and Nishio (U.S. Patent No. 6,045,164). Each of these rejections is traversed.

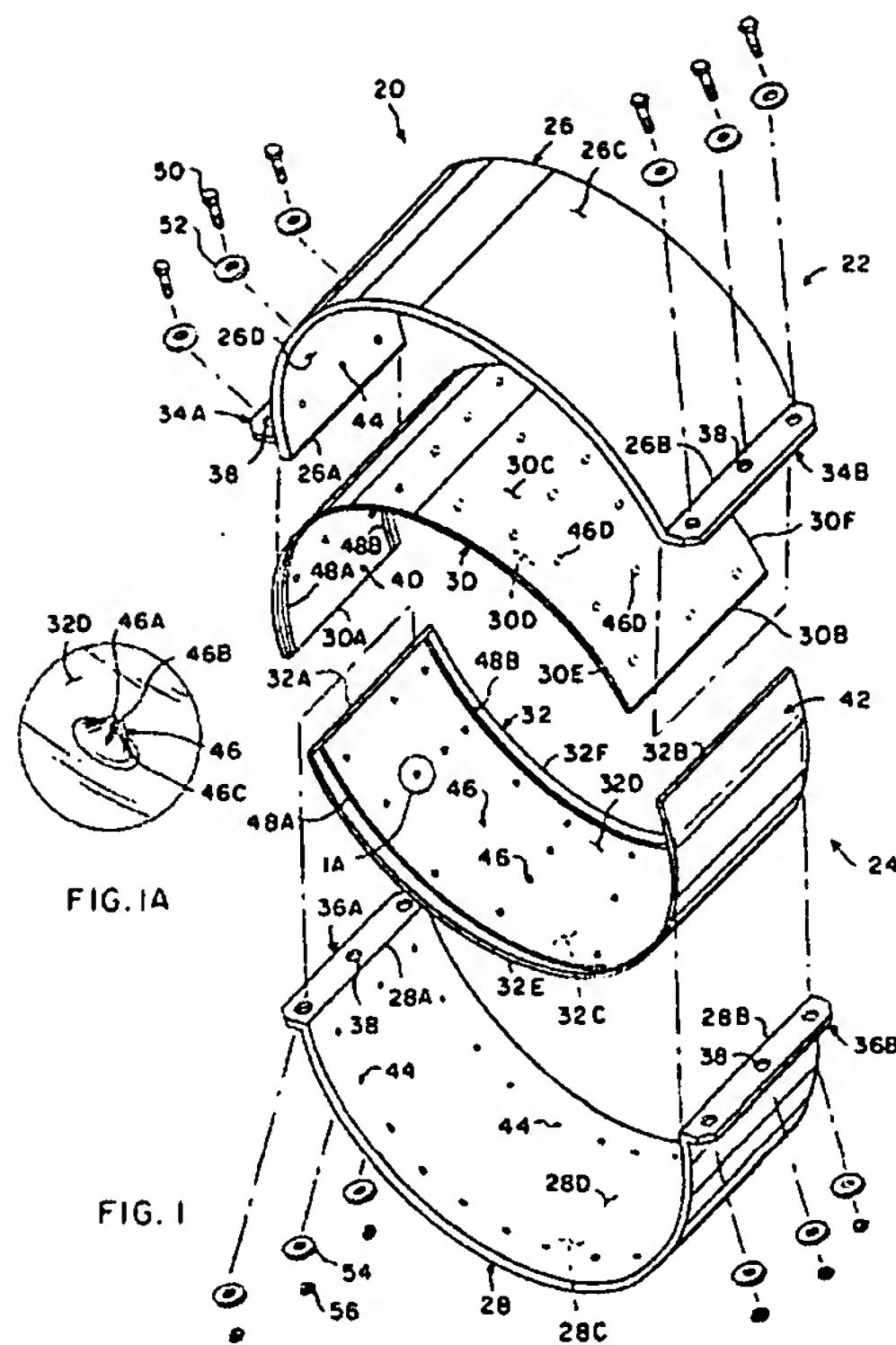
A. *Neither Williams et al., nor the secondary references, teach or suggest a slip collar including "an integral one-piece structure."*

Applicants submit that Williams et al. does not teach or suggest a slip collar that is a one piece integral structure. The Examiner takes the position that Williams et al. does teach a one piece integral structure, and alleges the following at page 15 of the Office Action:

Note "integral one-piece structure" only requires that as a finished product the slip collar is integral and is one piece. In this case, since the elements are bonded together by an adhesive to form a one-piece structure the slip collar of Williams et al. is an integral one-piece structure.

Applicants note that the position taken by the Examiner is contrary to the position taken by the Examiner in the interview dated January 17, 2006. As stated in the interview summary, the "one-piece" claim language was discussed in detail, and the Examiner states in the interview summary that "these proposed amendments, arguments, and declaration should overcome the Williams reference especially as used as a single reference rejection." During the interview, Applicants' representative sent the Examiner an actual sample of an embodiment of the invention, with a proposed amendment to state that the slip collar in the claims was an "integral" structure. After showing the sample of an embodiment of the invention to the Examiner and explaining the differences between Applicants' proposed claim language and Williams et al., the Examiner proposed adding the "one piece" limitation in addition to the Applicants' proposed "integral" claim language to further distinguish the claims from Williams et al. Despite the Examiner's own suggested claim language, the Examiner now takes the exact opposite position and alleges that Williams et al. teaches a "one piece" structure and has made the Office Action final without giving the Applicants a full and fair chance to respond to the Examiner's revised interpretation of the claim language proposed by the Examiner. In view of these events, Applicants request that the finality of the Office Action be withdrawn and that the next Office Action be made non-final. Although an RCE is being submitted in abundance of caution to ensure that Applicants' arguments are considered, if it determines that the finality of the prior Office Action was improper, the U.S.P.T.O. is requested to refund the fee for the RCE to the Applicants.

Despite the complete reversal of the Examiner's own interpretation of the phrase "one piece," Applicants again submit that Williams et al. fails to teach or suggest a slip collar that is in the form of an "an integral one-piece" structure. An exploded view of an exemplary duct joint in Williams et al. is shown below in FIG. 3. Given the vast number of screws, bolts, and pieces, Applicants submit that any allegation that the structure shown in FIG. 3 is an "integral, one piece" structure is inherently unreasonable. Accordingly, the obviousness rejection should be withdrawn for this reason alone.



B. *There is no motivation to modify Williams et al. in the manner proposed by the Examiner.*

The Examiner admits that Williams et al. fails to teach or suggest a fiber-reinforced plastic material. However, the Examiner states that Shea '994 teaches the use of a fiberglass reinforced plastic, and that one would have used a fiber reinforced plastic in Williams et al.'s duct joining system to "form lighter ducts". The Examiner refers to column 1, lines 44-47 of Shea '994. However, this passage does not state that fiber reinforced plastics are lighter than metal. Accordingly, there is no motivation in the prior art to modify Williams et al. in the manner proposed by the Examiner, and obviousness has not been established.

C. *The Plecnik Declaration*

Applicants previously submitted a Declaration of Joseph Plecnik Pursuant to 37 C.F.R. § 1.132 ("the Plecnik Declaration"). In response to the Plecnik Declaration, the Examiner states the following:

The declaration does not overcome the new 35 U.S.C. 103 rejections for two major reasons. First, the declaration is provided to show that the claimed integral one-piece structure is unobvious over the slip collar of Williams et al. However, the Williams et al. reference anticipates the integral one-piece structure limitation Second, the declaration does not provide evidence or facts of unexpected result[s]. It is well settled that unexpected results must be established by factual evidence (716.01(c)). ... Furthermore, any differences between the claimed invention and the prior art may be expected to result in some differences in properties. This issue is whether the properties differ to such an extent that the difference is really unexpected (MPEP 716.02).

Applicants traverse the Examiner's allegation that the Plecnik Declaration is not persuasive. First, as explained above, Williams et al. does not teach or suggest the "integral, one piece structure" limitation in the claims. The Plecnik Declaration (at paragraph 6) also states that embodiments of the invention are directed to a "one piece" construction, that a one piece construction is not taught by Williams et al., and that embodiments of the invention have advantages over Williams et al.'s multi-piece construction. Second, while the Examiner alleges that no unexpected results are shown in the Plecnik Declaration, the Plecnik Declaration and the specification clearly show unexpected results and advantages are achieved by embodiments of the invention (see paragraphs 5-8). The results and advantages provided by embodiments of the invention are "unexpected", because the Examiner has not shown that they would have been "expected" by the prior art.

The advantages provided by embodiments of the invention were extensively discussed in Applicants' prior Amendment, but were dismissed without comment by the Examiner. However, pursuant to MPEP 707.07(f), Applicants respectfully request that the Examiner address all of Applicants asserted advantages. MPEP 707.07(f) states:

ANSWERING ASSERTED ADVANTAGES

After an Office action, the response (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed.

If it is the examiner's considered opinion that the asserted advantages are without significance in determining patentability of the rejected claims, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised.

The importance of answering such arguments is illustrated by *In re Herrmann* **>261 F.2d 598, 120 USPQ 182 (CCPA 1958)< where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable.

>See also *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed Cir. 1995) (Office failed to rebut applicant's argument).<

Lastly, the Examiner alleges that the Plecnik Declaration does not provide evidence or facts of unexpected results. The Plecnik Declaration is evidence, as it contains opinions by a third party declarant with relevant knowledge. See MPEP 716.01(c) (III). Accordingly, the Examiner allegation that the Plecnik Declaration somehow is not evidence or does not contain facts is directly contrary to the MPEP.

As explained above, the present claims are allowable without the Plecnik Declaration, because obviousness has not been established. The Plecnik Declaration provides yet additional reasons why embodiments of the invention are allowable over the prior art.

CONCLUSION

Applicants submit that there are more reasons why one would conclude that embodiments of the invention are patentable, rather than unpatentable. A Notice of Allowance is therefore earnestly and respectfully solicited.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Patrick R. Jewik', is written over a horizontal line.

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